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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,785	02/28/2002	John A. Scott	112056-0048	8989

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EXAMINER	
CORRIELUS, JEAN M	
ART UNIT	**PAPER NUMBER**
2162	

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/086,785	SCOTT, JOHN A.	
	Examiner	Art Unit	
	Jean M. Corrielus	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32 and 34-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32 and 34-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. This office action is in response to the amendment filed on May 10, 2006, in which claims 1-38 are presented for further examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-32 and 34-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 4, 20 and 32 recite "a series of actions to perform on element of the file access data structure". It is unclear as to which series of actions the applicant is relied upon. There is no indication in the claim to clarify what kind of action needed to perform on the element of the file access data structure. Claims 2, 15 and 34 recite "a critical path data structure" and "set of specific code". It is unclear to one having ordinary skill in the art of seems to be the critical path data structure. Critical path is not defined in the claimed. It is also not clear as to what the specific code functions the applicant is relied upon. Claims 7 and 37 recite "performing an action". It is not clear as to what kind of action to perform.
While converting element of a file access data structure from a first endianness to a second endianness could reasonably be considered a transformation, the body of claims 1, 4, 7, 16, 20,

26, 32, 34 and 37 doesn't appear to actually support the preamble by including a step or steps, which accomplish that act. There does not appear to be anything subjective to raise an issue with the claim produces a concrete result. Claim 34 appears to have no claimed result under the condition where the file access data structure is not critical. Claim 37 recites "stepping through the description". It is not clear as to what the applicant means by "stepping through the description". Claims 1-32 and 34-39 recite "to convert the file data structure from first endianness to second endianness". Such limitation is intent to transform the file data structure from first endianness to second endianness. It appears the actual transformation is not yet taking place. Claims 22, 23, 28 and 29 recite "it". Applicant is reminded that pronouns are not permitted, only what is being referred by "it" should be set forth in the claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-32 and 34-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-32 and 34-38 in view of **MPEP section 2106 IV.B.2. (b)** are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter

under 35 U.S.C. 101.

Thus, the claimed are rejected as being non-statutory. Additionally, the invention, as claimed, is directed to the manipulation of an abstract idea with no practical application in the technology arts.

The Supreme Court has repeatedly held that abstractions are not patentable. "An idea of itself is not patentable". Rubber-Tip Pencil Co. V. Howard, 20 wall. 498, 07. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basis tolls of scientific and technological work Gottschalk V. Benson, 175 USPQ 673, 675 (S Ct 1972). It is a common place that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter Parker V. Flook, 197 USPQ 193, 201 (S Ct 1978). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Wamerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant should duly note that the claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Claims 1, 2, 4, 7, 15, 16, 20, 26, 32, 34 and 37 represent an abstract idea, which does not tie to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. There is no manipulation of data or any transformation of data from one state to another being performed in the method of communicating with a controller in real time. Actually, no post computer process activity is found in the technological arts. The method of communication with a controller is not a physical transformation. The controller by itself cannot perform any function without being coupled to a processor of a computer system. Assuming the database is a physical hardware or a memory, such controller cannot communicate with memory without coupling in a possessor of a computer system. Thus, no physical transformation is performed, no practical application is found in the claims. The preamble of the claims 1, 2, 4, 7,

15, 16, 20, 26, 32, 34 and 37 state "converting a file access data structure from a first endianness to a second endianness". While converting element of a file access data structure from a first endianness to a second endianness could reasonably be considered a transformation, the body of claims 1, 4, 7, 16, 20, 26, 32, 34 and 37 doesn't appear to actually support the preamble by including a step or steps, which accomplish that act. The claims do not appear to be anything subjective to raise an issue with whether it produces a concrete result. Although the file access data structure transforms to a requesting client representative, the invention as claimed does not produce a concrete, useful and tangible result to form the basis of statutory subject matter. However, the invention, as claimed, is directed to the manipulation of an abstract idea with no practical application in the technology arts, there is no physical transformation performed in the claim nor providing a concrete, useful, and tangible result. The recited "to convert the file data structure from first endianness to second endianness", in claims 1, 2, 4, 7, 15, 16, 20, 26, 32, 34 and 37, is just an intended use statement to transform the file data structure from first endianness to second endianness. It appears the actual transformation is not yet taking place. Therefore, claims 1, 2, 4, 7, 15, 16, 20, 26, 32, 34 and 37 are directed to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Applicant is advised to amend the claims to show the series of steps as recited in claims 1, 2, 4, 7, 15, 16, 20, 26, 32, 34 and 37 produce a concrete, useful and tangible result ***being executed*** by a general-purpose computer in order to correct the above indicated deficiencies.

These limitations do not produce any useful, concrete and tangible result. Applicant is advised to amend the claims to show the series of steps as recited in claim 23 produce a tangible result ***being executed*** by a general-purpose computer in order to correct the above indicated deficiencies.

The dependent claims 3-6, 8-14, 17-19, 21-25, 27-31 and 35-38 are rejected for fully incorporating the errors of their respective base claims by dependency. Thus, claim 3-6, 8-14, 17-19, 21-25, 27-31 and 35-38 are merely abstract idea and are being processed without producing a concrete, useful and tangible result to form the basis of statutory subject matter.

Allowable Subject Matter

7. Claims 1-32 and 34-38 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 112, 2nd paragraph, set forth in this Office action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jean M. Corrielus
Primary Examiner
Art Unit 2162

July 15, 2006